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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/532,995 | 11/18/2005 | Kiyoshi Yagi | Q87740 | 9113 |

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| EXAMINER | |
|---|---|
| RONESI, VICKEY M | |

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| 1796 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/532,995 | YAGI ET AL. | |
| | Examiner | Art Unit | |
| | VICKEY RONESI | 1796 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 April 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/28/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Objections*

1. Claims 5 and 7 are objected to because of the following reasons:

With respect to claim 5, "polyamide fibers" in line 3 should be replaced with "ultrafine nylon fibers" because "polyamide fibers" are broader in scope than the "ultrafine nylon fibers" of claim 1.

With respect to claim 7, "polyamide fibers" in line 2 should be replaced with "ultrafine nylon fibers" because "polyamide fibers" are broader in scope than the "ultrafine nylon fibers" of claim 1.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by JP '570 (JP 11-106570).

Pending a full English-language translation of JP '570, in setting forth this rejection, a machine translation has been relied upon.

JP '570 discloses a resin composition comprising a polyolefin-polyamide resin composition that is mixed with rubber or resin as reinforcement (paragraph 0001), wherein the polyolefin-polyamide resin composition comprises 90-40 parts by weight (pbw) polyolefin, 10-60 pbw polyamide fibers having an average fiber diameter of 1 micron or less and an aspect ratio of 20-1,000, and 0.1-5.5 pbw per 100 pbw, per total of polyolefin and polyamide, silane coupling agent (abstract). Note Table 2 which has the polyolefin-polyamide resin composition mixed with NBR (nitrile butadiene rubber) or PE (polyethylene).

In light of the above, it is clear that JP '570 anticipates the presently cited claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '570 (JP 11-106570) in view of Sugiyama et al (US 4,082,909).

The discussion with respect to JP '570 in paragraph 2 above is incorporated here by reference.

JP '570 discloses the use of a filler such as "white carbon," but fails to exemplify or teach the use of silica.

Sugiyama et al teaches that silica is also known as "white carbon" (col. 2, lines 26-27).

Given that JP '570 teaches the use of a white carbon filler which is equivalent to silica as taught by Sugiyama et al, it would have been obvious to one of ordinary skill in the art utilize silica in the polyolefin-polyamide resin composition taught by JP '570.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '570 (JP 11-106570) in view of JP '464 (JP 11-302464).

The discussion with respect to JP '570 in paragraph 2 above is incorporated here by reference.

JP '570 fails to disclose the use of its polyolefin-polyamide resin composition in a composition for a sheath in an electric wire.

JP '464 discloses a composition comprising polyethylene, polyamide fibers, and a silane coupling agent for use in electric wires.

Given that JP '570 discloses a composition comprising polyethylene, polyamide fibers, and a silane coupling agent that is further mixed with polyethylene and further given that JP '464 teaches that a composition comprising those ingredients are suitable for use in electric wires, it would have been obvious to one of ordinary skill in the art to utilize the compostion of JP '570 in an electric wire.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Two (2) double patenting rejections are set forth below.

*Double Patenting, I*

5. Claims 1-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim1 and 4-6 of U.S. Patent No. 7,041,726. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

US '726 claims an insulating member prepared by mixing a base resin with polyamide ultrafine fibers-dispersed polyolefin resin composition comprised of polyolefin, polyamide fibers, a silane coupling agent, and silica particles--wherein the blend ratio of polyolefin to polyamide fibers in the polyamide ultrafine fibers-dispersed polyolefin resin composition is from 5:5 to 9:1, preferably 8:2, and the mean fiber diameter of the polyamide fiber is not greater than

1 micron and has an aspect ratio of 20-1000. It is noted that even US '726 claims an insulating member, it is also discloses a composition which reads on the instant composition claims.

While US '726 does not claim specific base resin, note col. 11, line 5 where US '726 teaches that the base resin can be polyethylene or polypropylene (i.e., polyolefins). Furthermore, the examples of US '726 contain polyethylene. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention. Therefore, it would have been obvious to one of ordinary skill in the art to utilize a polyolefin as the base resin of US '726.

*Double Patenting, II*

6. Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4 and 5 of copending Application No. 10/533,159 (published as US 2006/0241221). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

US appl. '159 claims a polyolefin resin composition comprising polyolefin and polyamide ultrafine fibers-dispersed polyolefin resin composition comprising silica particles in a ratio of polyolefin to poyamide of 1:1 to 9:1. The scope of the instant claims encompasses the scope of US appl. '159. Therefore, the instant invention is *prima facie* obvious over the claims of US appl. '159.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-4 are directed to an invention not patentably distinct from claims 4 and 5 of commonly assigned copending Application No. 10/533,159 (published as US 2006/0241221). Specifically, see the discussion set forth in paragraph 6 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned copending Application No. 10/533,159 (published as US 2006/0241221), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/26/2008
vr

/Vickey Ronesi/
Examiner, Art Unit 1796